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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,332	07/21/2004	Renato Ancorotti	ARC-5506-4	8959
23117 7590 12/22/2010 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER AHMED, HASAN SYED				
ART UNIT		PAPER NUMBER		
1615				
MAIL DATE		DELIVERY MODE		
12/22/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,332

Applicant(s)

ANCOROTTI, RENATO

Examiner

HASAN S. AHMED

Art Unit

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 19, 21, 24, 25, 27-30, 32, 35, 36, 38-40, 42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 19, 21, 24, 25, 27-30, 32, 35, 36, 38-40, 42, and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of applicant's pre-appeal brief request for review, filed on 18 August 2010. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

* * * * *

Status of the Claims

Claims 1-17, 20, 22, 23, 26, 31, 33, 34, 37, and 41 are cancelled. Claims 18, 19, 21, 24, 25, 27-30, 32, 35, 36, 38-40, 42, and 43 are currently pending and rejected.

* * * * *

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18, 29, 42, and 43 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, examiner respectfully submits that support for the limitation "non-pressed powder" (see amendments filed on 10 January 2008 and 6 July 2007) is lacking and the addition of said limitation is new matter.

The instant specification does not disclose a "non-pressed powder"; no examples or embodiments disclose a "non-pressed powder". To the contrary, the specification distinguishes the disclosed composition from "conventional products" such as "pressed or non-pressed powders" (see filed specification, page 7, lines 20-21).

The phrase "non-pressed powders" is recited in two different portions of the specification. At page 1, line 19 of the filed specification, advantages and disadvantages of non-pressed powders are discussed in the background section of the specification. This discussion does not suggest that non-pressed powders are a product being disclosed. Further, as indicated above, page 7, lines 19-22 explain that, "[t]he products obtained by means of the process of the invention therefore represent a valid alternative to the conventional products such as in [sic] pressed or non-pressed powders and creamy type products." Emphasis supplied. Thus, the instant disclosure explicitly states that what is being disclosed is an alternative to non-pressed powders; yet, non-pressed powders are now being claimed by amendment.

Further evidence that "non-pressed powders" have not been disclosed is found in the recital of shaping and sizing of the dried product throughout the specification (see, e.g., page 6, lines 4-5 and page 7, lines 9-12 of the filed specification) and in the claims (see claims 40, 42, and 43). Non-pressed powders are loose and cannot be shaped or sized; shaping and sizing can only occur with a solid composition that has emerged from an extruder, where the dies give the product the desired shape (see, e.g., instant filed specification, page 6, lines 26-27). In the process of extrusion and shaping, the powders are compressed. The instant specification also states that "[o]nce drying has

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been completed, the product can be visually checked to identify any defects and hardness can be checked by means of a dynamometer." See page 7, lines 6-8 of the specification as filed. It is respectfully submitted that a non-pressed, or loose powder does not have any hardness because it is not formed into a cohesive unit; only a pressed composition will have any measurable hardness.

To summarize, given the totality of the disclosure, examiner respectfully submits that the concept of "non-pressed powder" recited in the amended claims has not been disclosed and the limitation constitutes new matter.

* * * * *

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 19, 21, 24, 25, 27-30, 32, 35, 36, 38-40, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,858,381 ("Le Bras") (see form PTO-892, attached) in view of U.S. Patent No. 4,994,264 ("Verdon") (cited on the IDS filed on 28 June 2004).

Le Bras teaches a cosmetic composition prepared by extrusion (see col. 1, lines 10-15). The composition may be packaged in particulate form (see col. 3, line 7), suggesting the non-pressed powder of claims 18, 29, 42, and 43. The formulation of Example 1 (see col. 11, lines 30-43) further suggests a non-pressed powder.

Le Bras explains that the disclosed composition has "remarkable hiding power and...allows a translucent make-up of completely natural appearance to be obtained." See col. 2, lines 65-67.

The disclosed composition comprises a pulverulent fraction dispersed in a binder consisting of an emulsion comprising a fatty phase and an aqueous phase, suggesting the fatty emulsion of claims 18(a'), 29(a'), 42(a'), and 43(a') (see col. 3, lines 62-65).

The pulverulent fraction may comprise at least one pigment (see col. 4, line 33), including inorganic pigments, organic pigments, and pearlescent pigments, suggesting the coloring powders comprising matte, pearly, synthetic, or natural pigments of claims 18(a''), 29(a''), 42(a''), and 43(a'').

The pulverulent fraction may further comprise fillers such as talc and mica, suggesting the inert powders of claims 18(a''), 29(a''), 42(a''), and 43(a'').

The disclosed emulsion comprises water (see col. 7, line 7) and a fatty constituent, such as olive oil (see col. 7, lines 19-20), suggesting the emulsion of claims 18(a'), 29(a'), 42(a'), and 43(a') and the fats of claims 19 and 30.

The fatty phase and aqueous phase (i.e. emulsion) and the pulverulent fraction (including pigment powder) are mixed prior to extrusion (see, e.g., claim 1), suggesting the mixing step of claims 18(b), 29(b), 42(b), and 43(b).

Regarding the about 50/50% proportion of fatty emulsion to coloring powder of claims 18(b), 29(b), 42(b), and 43(b), the formulation of Example 1 (see col. 11, lines 30-43) discloses 8 parts pigment (i.e., 1.04 parts yellow iron oxide, 0.52 parts red-yellow iron oxide, 0.14 parts black iron oxide, and 6.3 parts titanium dioxide) and 7.17 parts

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fatty phase (i.e. 1.38 parts stearic acid, 1.38 parts glyceryl stearate, and 4.41 parts isoparaffin). A prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05. Alternatively, Verdon teaches a powder make-up composition made by extrusion of a fatty emulsion and coloring powders, wherein the fatty emulsion to coloring powders proportion may be about 50/50% by weight (i.e. the disclosed concentration of cosmetic coloring agents is 0-50% with, e.g., 5-60% water, 0.01-20% polar solvent other than water, 0.1-15% emollients, and 0.01-5% fragrance oils) (see claims 8 and 9).

The fatty phase and aqueous phase (i.e. emulsion) and the pulverulent fraction (including pigment powder) are then extruded (see e.g., col. 8, lines 30-41) and a "homogeneous pasty composition" (see col. 2, lines 63-64) emerges, suggesting the extrusion step and resulting semi-solid extruded product of claims 18(c), 29(c), 42(c), and 43(c).

The paste can then be dried in an oven (see, e.g., col. 3, lines 42-43), suggesting claims 18(d), 25, 29(d), 36, 42(d), and 43(d). While Le Bras does not explicitly disclose the drying temperature range and humidity recited in claims 18(d), 29(d), 42(d), and 43(d), Verdon teaches a powder make-up composition made by extrusion of a fatty emulsion and coloring powders wherein the composition is dried after extrusion at a temperature of about 40 to 55 degrees C to a final moisture content of about 0.25 to 7% (see col. 4, lines 34-36).

Regarding claims 21 and 32, Le Bras teaches thickeners as additives to the disclosed emulsion (see col. 8, lines 14-22).

Regarding claims 24 and 35, Le Bras teaches the extrusion step using an extruder (see, e.g., col. 8, line 35).

Regarding claims 27 and 38, Le Bras teaches a cosmetic composition for making up the skin (see, e.g., col. 1, lines 10-15).

Regarding claims 28 and 39, Le Bras teaches a powdered foundation applied to the face (see col. 11, lines 48-49), suggesting a blusher.

Regarding claims 40, 42, and 43, Le Bras teaches that the disclosed pasty composition can be "formed in any manner whatever, especially by molding" (see col. 3, lines 46-47), suggesting sizing.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose process of making a make-up cosmetic comprising mixing a fatty emulsion and coloring powders, extruding the resulting paste, drying and sizing the extruded product, as taught by Le Bras in view of Verdon. One of ordinary skill in the art at the time the invention was made would have been motivated to use such a process because it results in a product which has remarkable hiding power and is translucent and of completely natural appearance, as explained by Le Bras (see above).

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HASAN S. AHMED whose telephone number is (571)272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Wax can be reached on (571)272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. S. A./
Examiner, Art Unit 1615

/Robert A. Wax/
Supervisory Patent Examiner
Art Unit 1615